

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,175	03/17/2004	Theodor Funck	46955.13	3846
23973	7590 09/13/2006	EXAMINER		
	BIDDLE & REATH	LIN, JERRY		
	ELLECTUAL PROPER' N SQUARE	ART UNIT	PAPER NUMBER	
18TH AND	CHERRY STREETS	1631		
PHILADELPHIA, PA 19103-6996			DATE MAILED: 09/13/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<i></i> .v
- V
\sim

	Application No.	Applicant(s)				
Office Action Commons	10/802,175	FUNCK, THEODOR				
Office Action Summary	Examiner	Art Unit				
•	Jerry Lin	1631				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status						
1) Responsive to communication(s) filed on 17 Ma	arch 2004.					
	action is non-final.					
3) Since this application is in condition for allowan	nce this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims						
4) Claim(s) 1-18 is/are pending in the application.						
4a) Of the above claim(s) is/are withdraw	n from consideration.					
5) Claim(s) is/are allowed.						
6) Claim(s) is/are rejected.						
7) Claim(s) is/are objected to.						
8)⊠ Claim(s) <u>1-18</u> are subject to restriction and/or e	election requirement.					
Application Papers						
9) The specification is objected to by the Examiner	ſ.					
10) The drawing(s) filed on is/are: a) acce	epted or b) \square objected to by the E	Examiner.				
Applicant may not request that any objection to the o	drawing(s) be held in abeyance. See	37 CFR 1.85(a).				
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
Priority under 35 U.S.C. § 119						
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 						
2. Certified copies of the priority documents have been received in Application No						
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
Attachment(s)						
1) Notice of References Cited (PTO-892)	4) Interview Summary					
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO/SB/08)	Paper No(s)/Mail Da 5) Notice of Informal Pa					
Paper No(s)/Mail Date	6) Other:					

DETAILED ACTION

Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Claims 1-14, drawn to a method of diagnostic investigation, classified in class 702, subclass 19. (Species Election Required)
 - II. Claims 15-18, drawn to an apparatus for diagnostic investigation, classified in class 422, subclass 68.1.

The inventions are distinct, each from the other because of the following reasons:

2. Group I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method in Group I may be practiced by hand. For example, the viscosity of a liquid sample may determine the health of an organism. Viscosity may be determined visually by inspecting a sample. If a sample is too thick, then it indicates a diagnosis. On common test is in semen analysis, where increase viscosity may be an indication of a prostate infection. Thus the process as claimed in Group I, can be practiced by another method.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

Art Unit: 1631

because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Species Election for Group I

3. This application contains claims directed to the following patentably distinct species:

Species A, (claims 2, 13 and 14) different physical quantities. (please elect one physical quantity from claim 2, and indicate if claims 13 and 14 also read on the elected physical quantity)

The species are independent or distinct because:

The different physical quantities are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the species each have a different design and different mode of operation. For example, the measurement of viscosity requires different methods and techniques than the measurement of compressibility. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Application/Control Number: 10/802,175

Art Unit: 1631

4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1,3-12 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Lin whose telephone number is (571) 272-2561. The examiner can normally be reached on 10:00am-6:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Representatives are available to answer your questions daily from 6 am to midnight (EST). When calling please have

Application/Control Number: 10/802,175

Art Unit: 1631

Page 6

your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center at (800) 786-9199.

MICHAEL BORIN, PH.D PRIMARY EXAMINER

JL